

Appl. No. 10/731,937  
Atty. Docket No. CM1976C  
Amdt. dated 5/10/06  
Reply to Office Action of 2/23/06  
Customer No. 27752

### REMARKS/ARGUMENTS

Claims 1 and 4 are under consideration.

Claim 1 has been amended herewith to further highlight the "problem/solution" aspects of the present invention.

The term "pin-holes" is found in the specification at page 4, line 9. The description of the solvent-based ink migration through the aluminum and into the underlying lacquer is found at page 2, lines 13-15. The solution to the problem using the water-based primer to prevent solvent migration is disclosed at page 3, first paragraph. The term "consists of" has been replaced by the original term "comprising."

It is submitted that all amendments are fully supported, and entry is requested.

#### Rejections Under 35 USC 112

It is submitted that the amendment to Claim 1 ("comprising" term) fully meets the rejection at page 2 of the Office Action. Withdrawal of the rejection is requested.

#### Rejections Under 35 USC 103

Claims 1 and 4 stand rejected over the assertedly "admitted" prior art in view of WO 93/08084, JP 60-28459 Abstract, U.S. 5,200,253, U.S. 5,658,968 and U.S. 4,571,363.

Applicants respectfully traverse the rejections, to the extent they may apply to the claims, as now amended.

Earlier comments and arguments in support of patentability continue to apply, but will not be exhaustively repeated herein, for the sake of brevity.

However, in order to preserve a complete and focused record for appeal, should an appeal ultimately prove necessary, some repetition of previous arguments may be unavoidable.

At the outset, it is noted that the Examiner has combined bits-and-pieces of some five documents and combined them with some nebulous "admitted" prior art to, assertedly, arrive at the present invention.

As the Examiner is aware, there must be some teaching, suggestion or motivation to combine references. MPEP 2143. No such rationale is readily apparent herein.

As the Examiner is also aware, discovery of a problem must be considered as part of the "subject matter as a whole" test under §103. MPEP 2141.02. Clearly, none of the cited documents teaches the "pin-hole/solvent migration/dissolution" problem discovered by Applicants.

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With regard to the state of the “admitted” art, it would appear to be relevant to consider the cited ‘968 patent. Indeed, it is respectfully submitted that ‘968 can be fairly characterized as teaching away from the present invention. While the Examiner has cited various passages from ‘968 in support of the rejections, it is noted that still other teachings from ‘968 are relevant and must also be considered.

At column 1, lines 27-30, the ‘968 patent teaches, “In addition, solvent-borne flexible packaging inks are generally not receptive to water-borne primers or adhesives.”

Again, at column 1, lines 43-50, the ‘968 patent teaches, “A unique problem faced by solvent-borne flexible packaging inks is that they are ordinarily not receptive to water-borne primers and adhesives, which printers now prefer. It was necessary to use an ink/primer/adhesive system which was either entirely solvent-borne or water-borne. This has prevented the widespread use of solvent-born flexible packaging inks in conjunction with water-borne primers and adhesives.” [emphasis supplied]

In sharp contrast to these teachings of ‘968, Applicants herein have discovered that a water based primer comprising acrylic compounds can be used with solvent based inks comprising ethanol or ethyl acetate solvents, all as specified in the claims.

It is submitted that ‘968 not only does not fairly suggest the aforesaid primer/ink combination, but also constitutes a summary of the art that would dissuade the skilled practitioner from making such combination, absent the special inks of ‘968. Said another way, ‘968 assertedly solves the problem with a special ink. The present inventors solve the problem using a selected water based primer (acrylics) with selected solvent based inks (ethanol/ethyl acetate).

The previous discussion of WO 93/08084 continues to apply, but will not be repeated here, for the sake of brevity.

Even assuming *arguendo* that WO 93 would have even recognized the problems solved by the present invention, the “state of the art,” as documented in ‘968, would appear to teach: Don’t use a water based primer with a solvent based ink.

Nothing in this combination of WO 93 with ‘968, in view of the “state of the art” would:

- i) Suggest the aluminum layer penetration problem discovered herein (a §103 factor, as noted above);
- ii) Suggest using a water based primer;
- iii) Suggest that said primer comprise acrylic compounds, which make them usable with solvent based inks, as disclosed herein and in contrast with the “state of the art.”

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Previous comments regarding '253, alone or in combination with other cited documents, continue to apply.

In particular regard to the passage of '253 at column 18, lines 4-17 specifically cited by the Examiner (Office Action page 4), it is noted that the primer layer 115 "may be formed of various lacquers" and "ink layers 119 may be provided on the surface of the primer layer 115 as shown in Fig. 24."

It is submitted that "lacquer" layers are typically laid down from an organic solvent. (Indeed, JP 60-28459 Abstract is cited by the Examiner for its teaching of various organic solvents for acrylic lacquer.) Thus, printing on an organic-laid lacquer layer is the exact opposite of the present invention, which employs a water-based primer to avoid the migration of organic ink solvents therethrough.

With regard to JP '60, it is submitted that this Abstract does no more than list various lacquer solvents. It neither teaches nor suggests either the problem herein, or its solution. Indeed, the solvents disclosed in JP '60 might fairly be said to be, in conjunction with the aluminum pin-holes, the cause of the problem herein, rather than its solution.

The '363 document adds nothing to the foregoing documents, except to disclose the asserted superiority of PET primer coated with crosslinked acrylic copolymer comprising a cross-linkable co-monomer. (Column 2, lines 20-23.) Again, the relevance of this teaching to the present invention is tenuous. Nothing therein relates to the problems associated with hologram formation, much less to the present solution. Printing on a water-based primer-coated aluminum is simply not suggested, in the manner of the present invention.

To summarize: It seems undisputed that the problem identified and solved by the inventors herein, and in the manner disclosed and claimed, is not fairly suggested by the cited combination of art. Indeed, some of the cited documents teach away from Applicants' solution to the problem. Others, arguably, might-or-might-not provide different solutions, but that is irrelevant to the present invention. Still others merely comprise listings of various ingredients which could be used herein, but only after the inventive aspects had been conceived by the Applicants. In short, it is submitted that the cited combination of documents is not permissible under MPEP 2143, and even if it were, it still does not support the rejections under §103. Withdrawal of the rejections is requested.

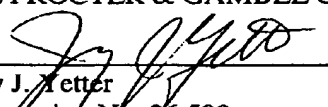
In light of the foregoing, early and favorable action on Claims 1 and 4, as amended, is requested.

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Respectfully submitted,

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